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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,237	05/03/2006	Hisanori Itoh	65108(71526)	1656
21874 7590 04/30/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
NAZARIO GONZALEZ, FORTRIO				
ART UNIT		PAPER NUMBER		
1621				
MAIL DATE		DELIVERY MODE		
04/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,237

**Applicant(s)**

ITO ET AL.

**Examiner**PORFIRIO NAZARIO  
GONZALEZ**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 17 is/are allowed.
- 6) ☒ Claim(s) 11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

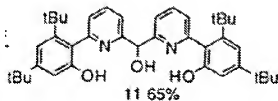
**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 02/15/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The English language translation of the Japanese foreign priority document submitted in accordance to 37 CFR 1.55(a)(4) filed January 23, 2008 is sufficient to overcome the rejection of claims 1-17 based upon the WO 2004/108857. Therefore, the rejection is withdrawn.
2. The amendment to claim 8, filed January 23, 2008 overcomes the rejection of claims 8-10 under 35 U.S.C. § 112, second paragraph set forth in the previous Office Action. Thus, the rejection is withdrawn.
3. The amendment to claim 11, filed January 23, 2008, does not overcome the rejection of claims 11 and 13-16 under 35 U.S.C. § 102(b) as anticipated by Zhang et al., as set forth in the previous Office Action. Note that compound 11 at page 1131 have the following formula



. Further note that this compound anticipates the claims when "Q<sup>1</sup>, Q<sup>2</sup>, and Q<sup>3</sup> each represent independently a bivalent atom (group) or a single bond providing that Q<sup>1</sup>, Q<sup>2</sup>, and Q<sup>3</sup> do not represent single bond simultaneously". Here Q<sup>1</sup> is -CH(OH)-, a bivalent group; Q<sup>2</sup> and Q<sup>3</sup> are independently a single bond; X<sup>1</sup> and X<sup>2</sup> are nitrogens atoms; X<sup>3</sup> and X<sup>4</sup> are carbons atoms; Z<sup>1</sup>H and Z<sup>2</sup>H are not present; and Z<sup>3</sup>H and Z<sup>4</sup>H are OH groups. Thus, the rejection stands.

Art Unit: 1621

4. The amendment to claims 11 and 17, filed January 23, 2008, only overcomes the rejection of claim 17 under 35 U.S.C. § 102(b) as anticipated by Bonnemann et al., as set forth in the previous Office Action. Note that the language in claim 11 (see the above paragraph) reads on the compound 13 of Bonnemann et al. when A is  $-(CH_2)_{1-8}-$  and R is  $C_6H_5$ . Thus, claims 11 and 13-16 stand rejected under 35 U.S.C. § 102(b) as anticipated by Bonnemann et al.

***Response to Arguments***

5. Applicant's arguments filed January 23, 2008 have been fully considered but they are not persuasive. Applicants' traversal does not particularly point out the defects of the rejection, thus, the rejection stands.

***Allowable Subject Matter***

6. Claims 1-10 and 17 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PORFIRIO NAZARIO GONZALEZ whose telephone number is (571)272-0641. The examiner can normally be reached on Mon.-Fri. (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Porfirio Nazario-Gonzalez/  
Primary Examiner  
Art Unit 1621

PNG  
April 28, 2008